



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/459,189	12/10/1999	Tim Haynes	4173/2	9761

29858 7590 01/17/2003

BROWN, RAYSMAN, MILLSTEIN, FELDER & STEINER LLP
900 THIRD AVENUE
NEW YORK, NY 10022

EXAMINER

KAPADIA, MILAN S

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 01/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/459,189

Applicant(s)

HAYNES ET AL.

Examiner

Milan S Kapadia

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 14.
- ☐ Interview Summary (PTO-413) Paper No(s) _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Art Unit: 3626

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 03 November 2002. Claims 1-25 are pending. Claims 1, 2, 3, 10, 12, 15, 16, and 17 have been amended.

Claim Rejections - 35 USC § 103

(A) The amendments to claims 1, 2, 3, 10, 12, 15, 16, and 17 appear to be grammatical or typographical in nature, but do not otherwise appear to change the scope of the claim as originally presented and in the manner addressed by the examiner in the previous Office Action (paper number 11) and are therefore rejected for the same reasons given in the prior Office Action (paper number 11, sections 3 and 4), pages 3-10), and incorporated herein.

(B) Claims 4-9, 11, 13, 14, and 18-25 have not been amended and are therefore rejected for the same reasons given in the prior Office Action (paper number 11, sections 3 and 4), pages 3-10), and incorporated herein.

Response to Arguments

2. Applicant's arguments filed 11/03/02 have been fully considered but they are not persuasive. Applicant's arguments will be addressed herein below in the order in which they appear in the response filed 11/03/02.

(A) At pages 8-10 and 13-15 of the 11/03/02 response, Applicant argues that "neither Danford-Klein et al. nor U-Haul disclose or suggest systems comprising memory in which the claimed data sets are stored, or in which is stored data relating expertise-based guidance relating to trucks or expertise-based guidance relating to towing accessories, or indeed provide any teaching or disclosure related to expertise-based guidance whatsoever " in reference to claims 1, 4-8, 9, 13, 14, 17, 18--25. In response, the Examiner respectfully submits that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In particular, the teachings that Applicant argues are missing from the Danford-Klein reference are clearly disclosed in the respective teachings of Uhaul, when considered collectively with that of Danford-Klein, as discussed in detail within a prior Office Action (paper number 11) and in the preceding rejections, and incorporated herein.

In addition, as shown above in the preceding rejections, Danford-Klein clearly teaches memory in which data sets are stored. The Examiner admitted that not all the

Art Unit: 3626

data sets are taught by Danford-Klein, but it is respectfully submitted that the data sets missing from Danford-Klein are taught by Uhaul, and as such memory containing these data sets are collectively taught by Danford-Klein and Uhaul. For example, the Examiner admitted that Danford-Klein failed to teach towing accessories and towed vehicles with which the towing accessories can be used and expertise-based guidance relating to trucks and towing accessories. However, Uhaul clearly teaches these limitations. In particular, on page 7 of the Uhaul reference, Uhaul teaches towing accessories (i.e., the tow bar and dolly) and towed vehicles with which the towing accessories can be used (i.e., the tow bar can be used with vehicles up to 5,000 lbs). Furthermore, on pages 12 and 13 of the Uhaul reference, Uhaul teaches expertise-based guidance relating to trucks (i.e., the 6' x 12' Trailer is recommended for the moving of 3 rooms") and towing accessories (i.e., 35 boxes are recommended for moving 3 rooms). Therefore, it is respectfully submitted that Danford-Klein and Uhaul collectively do teach systems comprising memory in which the claimed data sets are stored, or in which is stored data relating expertise-based guidance relating to trucks or expertise-based guidance relating to towing accessories.

Additionally, on page 9 Applicant argues "Danford-Klein et al. does not disclose data sets relating to trucks which can be rented, towing accessories, and associated rental prices for the trucks and towing accessories" in reference to claims 1 and 4-8. In response, the Examiner respectfully submits the Applicant has misinterpreted the full teachings of Danford-Klein. Danford-Klein clearly teaches data sets relating to trucks and associated rental prices for the trucks as discussed above in the preceding

Art Unit: 3626

rejections. The Examiner further points the Applicant to col. 17, lines 30-32 of the Danford-Klein reference, which also discloses that trucks can be rented for a specific price. Furthermore, it is respectfully submitted, that Danford-Klein does teach data sets relating to towing accessories and associated rental prices as discussed above in the preceding rejections. In particular Danford-Klein teaches accessories, for example flat beds and racks, that can also be rented based on mileage (Table 1). As such, Danford-Klein does teach data sets relating to trucks, which can be rented, towing accessories, and associated rental prices for the trucks and towing accessories.

(B) At pages 10-11 of the 11/03/02 response, Applicant argues that "...Examiner has properly reconstructed the claimed invention using hindsight" in reference to claims 2 and 4. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(C) At pages 11-12 of the 11/03/02 response, Applicant argues that "There is nothing

Art Unit: 3626

in the Deinford-Klein et al. reference to suggest that origination/destination for shipping goods is equivalent to pick-up and drop-off locations for a rental truck.” in reference to claims 3, 4, and 15. In response it is respectfully submitted, that as presently claimed, claim 3 states “...data set relating to vehicle pick-up and drop-off locations...” As such, it is respectfully submitted, that carrier used to ship goods is considered a “vehicle.” It is respectfully noted, that Danford-Klein further teaches that trucks can also be rented (col. 17, lines 30-32).

In addition, Applicant argues “...neither of these references discloses, or suggests a motivation for the claimed subject matter...” and “...Examiner’s rejection is based on the use of impermissible hindsight.” In response, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988)

Art Unit: 3626

(citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii)____non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest.

In the instant case, the Examiner respectfully notes that each and every motivation to combine the applied references are accompanied by select portions of the respective reference(s) which specifically support that particular motivation. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on

Art Unit: 3626

the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Furthermore, in response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

(D) At pages 12 and 13 of the 11/03/02 response, Applicant argues that "...Uhaul does not disclose or suggest the generation of a web page, provided in response to user input or data available from the system..." and "...Uhaul does not disclose or suggest the generation of a web page, provided in response to user input, that contains all reservation information provided, which may be changed by the user directly on the form without having to access another web page" in reference to claims 12 and 16. In response, the Examiner respectfully submits that Uhaul's reservation request form is provided in response to user input. If a user decides obtain an online rate quote by selecting the link (i.e., provides input (see page 4 of the Uhaul reference) then the

Art Unit: 3626

system does generate a web page in response to user input (Uhaul; pages 5-7).

Moreover, the web pages provided are based on "data available to the system." For example, the pull-down menus provided on page 6 of the Uhaul reference are definitely based on data of moving vans Uhaul provides, thus available to the system. In regards to arguments in reference to claim 16, similar reasoning applies and the preceding responses are incorporated herein (Also see MPEP § 608.01(m)).

(E) At page 15 of the 11/03/02 response, Applicant argues that "Neither...reference, either alone or in combination discloses or suggests any motivation..." in reference to claims 10 and 11. In response, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. And although the motivation or suggestion to make modifications must be articulated, it is respectfully submitted that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223

Art Unit: 3626

USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii)____non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would

suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA), obviousness is not based on express suggestion, but what references taken collectively would suggest. As such, it is NOT seen that the Examiner's combination of references is unsupported by the applied prior art of record. Rather, it is respectfully submitted that explanation based on the logic and scientific reasoning of one ordinarily skilled in the art at the time of the invention that support a holding of obviousness has been adequately provided by the motivations and reasons indicated by the Examiner, *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter., 4/22/93).

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milan S Kapadia whose telephone number is 703-305-3887. The examiner can normally be reached on Monday through Thursday, 8:30 A.M. to 6:00 P.M. In addition the examiner can be reached on alternate Fridays.

5. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone

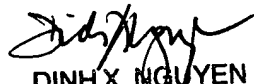
Art Unit: 3626

numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


mk

January 15, 2003


DINH X. NGUYEN
PRIMARY EXAMINER